

## **Remarks**

### **Status of the Claims**

Claims 30, and 33 have been amended to correct informalities. Specifically, in claim 30, “said housing of said receptacle” has been changed to “a receptacle,” and, the dependency of Claim 33 has been changed from 16 to 32. Applicants have also added new claims 38-43. Support for claims 38 and 41 can be found *inter alia* on page 6, lines 14-16. Support for claims 39 and 42 can be found *inter alia* on page 3, lines 12-15. Support for claims 40 and 43 can be found *inter alia* on page 7, lines 7-9. No new matter has been added.

### **Double Patenting**

The Examiner rejected Claims 1-30, 34-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-21 of U.S. Patent No. 6,517,382. In reply, Applicants respectfully wish to emphasize a terminal disclaimer based on U.S. Patent No. 6,517,382 was filed concurrently with the application (copy attached). Applicants therefore submit that this rejection is obviated and should be withdrawn.

### **Matters of Formality**

The Examiner rejected Claims 30 and 33 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Specifically, the Examiner stated the phrases “said housing of said receptacle” in claim 30 and “said latching member” in claim 33 lack antecedent basis. The Examiner also stated that the dependency of Claim 33 appears to be incorrect.

In reply, Applicants have amended Claims 30 to recite “a receptacle” rather than “said housing of said receptacle”. Additionally, Applicants have changed the dependency of claim 33 from 16 to 32. Applicants submit that these amendments obviate the Examiner’s rejections.

### **Prior Art Rejections**

The Examiner rejected Claims 26-31 and 33-37 under 35 U.S.C. §103(a) as being unpatentable over Smith (U.S. Patent No. 4,352,492) in view of Hall (U.S. Patent No.

4,388,671). Specifically, the Examiner stated that “Smith discloses the claimed invention except for a connector interface at the front of the housing . . . .” The Examiner found, however, that Hall discloses a connector interface at the front of the housing, the connector interface being adapted for receiving a connector of an electrical or optical conductor. The Examiner concluded that “it would have been obvious to one of ordinary in the art at the time the invention was made to modify Smith to provide the connector interface at the front of the housing as taught by Hall so as to supply signal to the system.”

In reply, Applicants respectfully submit that the claimed invention is patentability distinct over the combination of Smith and Hall.

#### **Claimed Invention**

The claimed invention provides for a compact, self-contained pluggable module and receptacle system which facilitates miniaturization and high operating frequencies by containing EMI emissions and conducting them to ground. In particular, Claims 26 and 36 are directed to a module for electrically connecting to a receptacle connector mounted to a host circuit board. As claimed, the module comprises a housing having a front/back and top/bottom orientation. The housing has a top wall, a bottom wall, a back wall and side walls. Each of the walls is planar. The module also comprises a planar module circuit board having an edge portion on which is disposed pads suitable for forming an electrical connection with contacts of the mating connector. The pads are enclosed by the planes of the top wall, the bottom wall, and the side walls. The front of the module also comprises a connector interface adapted for receiving a connector of an electrical or optical conductor. Claim 34 also recites features with respect to grounding and the mating action of the module circuit board with the receptacle connector.

#### **Prior Art**

##### **Smith**

Smith discloses a video game device for connection to a standard television set. The device has a receptacle for receiving a cartridge containing supplementary electronic circuitry and a pair of hand controls for providing player control inputs to the console electronics. As stated in Smith “the cartridge 28 includes preprogrammed electronics which cooperate with the

permanent electronics of the console to enable games other than those contained in the console circuitry to be played.” Column 3 lines 3 through 8. Specifically, “[t]he cartridge 28 contains additional PSU’s [program storage units] which add to the storage capability to the microprocessor and thus enable additional game and control data to effectively be included in the microprocessor 200.” Column 3 lines 59 through 62. Thus, the cartridge 28 provides additional memory for the game device. The video game device is controlled by joy sticks and selection button. Specifically, “game selection inputs are entered through the selection buttons 24, player control inputs are made through the hand controllers 12 and 14 and interchangeable game capability is provided by means of the cartridge 28.” Column 3 lines 47 through 51. Therefore, Smith is directed to a game device which is controlled by hand controllers 12, 14, and selection buttons 24 and is adapted to receive cartridges 28 to provide interchangeable game capability.

**Hall et al.:**

Hall discloses a cathode ray tube to display terminal which includes a pluggable logic board enclosure assembly 9. The assembly 9 comprises a keyboard 2 which “plugs into connector 18 by means of a cable 41 to provide logic signals to electronic components 35 mounted within the enclosure assembly 9.” Col 3, lines 15-17.

**Argument**

**There Is No Motivation to Modify the Cartridge of Smith to Have a Connector Interface as Disclosed in Hall since Such a Motivation Would Destroy the Principle of Operation of Smith**

There is no motivation to modify the cartridge of Smith to have a connector interface, such as connector 18 disclosed in Hall. *To the contrary*, such a modification would destroy the principle operation of the apparatus disclosed in Smith. It is well settled in U.S. patent law that there can be no motivation to modify a device disclosed by a reference if that modification would destroy the principle of operation of the device.

Here, Smith discloses a device for playing video games. It contains a receptacle to receive a cartridge containing additional PSUs as well as selection buttons and joy sticks to receive operator control signals. It is inconceivable to the Applicants why one would be motivated to modify the cartridge 28 to include a connector interface "to supply signal to the system" as suggested by the Examiner. First, there is no need for such a modification since the selection button and joy sticks already provide means for inputting control signals. Such a modification would therefore involve discarding the existing control inputs in favor of those implemented via the cartridge as suggested by the Examiner. Not only is this wasteful, but the modification also needlessly complicates the structure and function of the cartridge. The result is the intended function and operation of the Smith device is destroyed for a more complex, less desirable alternative. Clearly there can be no motivation for such a modification. Accordingly, the rejection should be withdrawn and the claims allowed.

**Allowable Subject Matter**

Applicants graciously acknowledge the Examiners finding of allowable subject matter in Claim 32. At this time, however, Applicants wish to forego amending this claim to make it independent pending the Examiner's reconsideration of the issues raised above.

Thank you.

Respectfully submitted,



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